REMARKS

The Amendments

The specification is amended to address the objection thereto.

The claims are amended to specify the particular machine, i.e., computer, aspects of the invention; see, e.g., original claims 25 and 29 and the specification at page 11, last paragraph, and page 12, first paragraph.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Objection to the Specification

The objection to the specification is respectfully traversed. Applicants submit that, since the exemplary forms which are alleged to be drawings are merely printed words in table form, they are not drawings. Tables are permissible in a specification and that is all that is presented here. However, applicants would consider canceling this subject matter if necessary. The claims are currently directed to a system containing a particular computer or method using a particular computer. Thus, the claims are no longer directed to paper forms or their use and it should no longer be necessary to show this aspect in drawings.

The Rejections under 35 U.S.C. §101

The several rejections under 35 U.S.C. §101 are respectfully traversed. The claims have

been amended so that they are directed to a system or method that is "tied to a particular machine." Thus, the claims fall within the requirements of In re Bilski, _ F.3d _, 88 U.S.P.Q.2d 1385 (Fed. Cir. Oct. 30, 2008). The systems and methods claimed require use of a computer, i.e., a machine, configured with particular data specific to the invention and a computer which is configured with particular computer-executable instructions, i.e., software, for carrying out the invention. Thus, the claims are not directed merely to software but are tied to a computer which is particularized by its unique combination of data and software for carrying out the invention. In accordance with the Bilski decision, it is urged that all of the rejections under 35 U.S.C. §101 should be withdrawn.

Rejections under 35 U.S.C. §103 rendered moot

The rejections recited in paragraphs 12-14, 22-25 and 30-32 are rendered moot since these rejections are not applicable to claims 25 or 29 and the substance of these claims is now incorporated into the two independent claims 1 and 2. It should be clear, however, that the reasons provided for traversing the rejections below also apply for traversing these rejections as well.

The Rejection under 35 U.S.C. §103 at paragraph 15

The rejection of claims 5-8, 25, 27, 29, 31, 34, 37 and 38 under 35 U.S.C. §103, as being obvious over Beinat (U.S. Patent No. 7,337,121) in view of AIG and in further view of DiRienzo (U.S. Patent No. 7,346,768), is respectfully traversed.

Beinat is directed to a computerized method for modeling the medical conditions of a

patient. Beinat has no relation at all to methods or systems for determining whether a claim for a defense under a liability insurance policy should be referred to a higher review level. The fact that Beinat uses the word "claimant" to describe the patient, e.g., at col. 4, lines 32-37, does not mean it relates to insurance claims, particularly a claim for a defense under a liability insurance policy. In short, Beinat simply has no relation at all to a system or method as claimed.

AIG discusses a integrated disability management system (IDM). The system includes a telephonic case management system that profiles incoming claims and identifies those most in need of case management. The system relates to identifying persons who need help with their disability claims. Thus, AIG also has no relation to methods or systems for determining whether a claim for a defense under a liability insurance policy should be referred to a higher review level. The AIG system has nothing to do with claims for a defense and nothing to do with a liability insurance policy. It relates only to identifying claimants who need help with their disability insurance claims. The description of the applicability of the claimed systems/methods, e.g., at page 2, last paragraph, of applicants' specification, should make clear the completely different nature of the claimed invention from the AIG system. Furthermore, the AIG system for identifying claimants who need help with their disability insurance claims (i.e., allegedly a higher level of review) is not a computer-implemented system. This part of the AIG system is a telephone-implemented task, i.e., paragraph 4 of AIG. Thus, even if AIG did disclose a system related to claims for defense under a liability insurance policy – which it does not – the elements of the claimed invention would still not be met or suggested.

DiRienzo teaches systems and methods for processing text messages integrated with digital attachments (see, e.g., Abstract). It is particularly applicable to preparing and processing

digital health insurance claims. Like the other references, DiRienzo has nothing to do with methods or systems for determining whether a claim for a defense under a liability insurance policy should be referred to a higher review level. The DiRienzo system has nothing to do with making a determination about referral for claims for a defense of a liability insurance policy. It relates only to preparing and processing health insurance claims, particularly to systems to allow integrated collection of data on the claim. DiRienzo teaches nothing related to a determination about the defense of such claims. Furthermore, DiRienzo appears to have no disclosure pertinent to the weighting aspect of the instant claims which was previously recited in claims 25 and 29 and is now recited in the independent claims. The quote in the Office action at pages 18-19 attributed to DiRienzo does not appear in DiRienzo but in the Beinat reference.

Because none of the references provide any teachings even marginally related to methods or systems for determining whether a claim for a defense under a liability insurance policy should be referred to a higher review level, it is urged that the combined teachings of the references also fail to render such a method or system obvious to one of ordinary skill in the art. In the absence of a teaching in any of the references of such a system or method, no combination of the references would result in this aspect of the claimed invention. The references, as a whole, teach nothing about referrals for legal defense of a liability insurance claim. Additionally, applicants fail to see the reasons for even making the combination of the reference teachings. They each relate to systems or methods for achieving distinct results and solving different types of problems. There is not a sufficient articulated reason provided as to why one of ordinary skill in the art would take different parts of these systems and combine them in the manner suggested in the Office action. In any event, even when so combined, the claimed invention is not achieved or

suggested.

For all of the above reasons, it is urged that the rejection under 35 U.S.C. §103 should be withdrawn.

The Rejection under 35 U.S.C. §103 at paragraph 26

The rejection of claims 13-16, 19, 20, 23, 24, 26, 28, 30 and 32 under 35 U.S.C. §103, as being obvious over Beinat (U.S. Patent No. 7,337,121) in view of AIG, further view of DiRienzo (U.S. Patent No. 7,346,768), further in view of Larkin (US 2002/0069089) and further in view of Crivella (US 2006/0282468), is respectfully traversed.

The discussion of Beinat, AIG and DiRienzo from above is equally applicable in traversing this rejection and is incorporated herein by reference. As discussed below, the teachings of Larkin and Crivella fail to make up for the above-discussed deficiencies of the first three references. Most pertinently, none of these references teach anything about a computer-implemented method for making referrals for legal defense of a liability insurance claim.

Larkin is directed to a computer-implemented method for case management of workplace-related injuries. The method includes steps for inputting data on the injuries, making diagnoses and setting forth a treatment plan. Larkin has no teachings related to making referrals for legal defense of a liability insurance claim, or anything related to insurance at all. Integration of the Larkin manner of form into any of the Beinat, AIG or DiRienzo systems would not result in or suggest the claimed invention.

Crivella relates to systems for integrating audio, visual and textual information for real-time interactive use by multiple users. Crivella has no teachings related to making referrals for

legal defense of a liability insurance claim, or anything related to insurance at all. Integration of the Crivella system into any of the Beinat, AIG, DiRienzo or Larkin systems would not result in or suggest the claimed invention since such a combination would still teach nothing about making referrals for legal defense of a liability insurance claim.

The combined teachings of Beinat, AIG, DiRienzo, Larkin and Crivella fail to render the claimed invention obvious to one of ordinary skill in the art. Since none of these references teach anything about a computer-implemented method for making referrals for legal defense of a liability insurance claim, it should be clear that their combination also fails to teach or suggest the claimed systems and methods.

Further, applicants disagree that claims 13-16, 19, 20, 23,2 4,2 6, 28, 30 and 32 refer merely to non-functional descriptive material. The categories recited in these claims relate to real data which is necessary to make the ultimate determination about referral for legal defense. Also, they are not claimed merely as descriptive material, per se, as alleged in the Office action. The claims which these claims depend on clearly set forth that the data is necessary for providing the function of the invention, i.e., the referral determination. Further, the data embodied by these categories is not merely printed matter nor matter analogous to music (as appears to be alleged in the action). The categories embody the data by which the computer is configured to be able to provide the referral determination, i.e., the data is partly responsible for making the computer a "particular machine" which makes it statutory subject matter in accordance with In re Bilski.

For all of the above reasons, it is urged that this rejection under 35 U.S.C. §103 should also be withdranwn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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